

for engaging opposite sides of an ossicle when implanted in a human ear, to anchor to the ossicle. A spring element is of a flexible material, different from the pair of jaws, and is operatively coupled to the jaws for biasing the jaws toward one another to provide clamping pressure. An actuator element is operatively coupled to the spring element.

Muller et al. does not disclose or suggest any jaw, let alone a pair of jaws. The element alleged to engage an ossicle is not of a bioactive material. Nor is there a spring element operatively coupled to jaws for biasing jaws toward one another to provide clamping pressure.

The action uses the claim language in referencing various elements of Muller et al. Doing so results in an incorrect statement of what is disclosed by Muller et al. For example, the action references element 34 as a pair of jaws having a semi-cylindrical inner surface for engaging opposite sides of an ossicle. In fact, element 34 is an attenuator. It is formed as a piece of hose, i.e., cylindrical, which has been slit lengthwise. It is a single element. It is cylindrical. It is in the nature of a cylindrical sleeve with a slit to allow it to be placed surrounding part of the ossicular chain. It is improper to characterize it as a jaw, let alone a pair of jaws, particularly as it is not semi-cylindrical. To even render it structurally similar would require putting a second slit in an opposite side so that there would be two semi-cylindrical pieces. However, doing so would render it inoperative. The specification describes that it is placed on the pertinent part of the ossicular chain. Because it is cylindrical, it would hold itself on prior to installing the coupling element 35. If it were formed of two semi-cylindrical pieces, one or both pieces would fall off. As such, it would not perform its intended function.

Moreover, the attenuator is formed of an elastic material, preferably a silicone resin. Such a device is not a bioactive material. A bioactive material elicits a favorable biologic response to form a bond. The use of a silicone sleeve would not provide this function. In fact, it is intended to operate as an attenuator, rather than an anchor to an ossicle. The action indicates that the alleged jaw could be formed of a bioactive material such as ceramic. This is contrary to the intended function of the attenuator 34. An attenuator is in the nature of a damping element. Ceramic would not function as a damping element. Likewise, hydroxyapatite would similarly not function as an attenuator. Muller et al. teaches away from ceramic devices by stating that the attenuators preferably a silicone resin. Also, a cylindrical device of ceramic could not be installed on the base.

The coupling element 35 comprises a unitary spring arm. It is pushed onto the attenuator to mount to the ossicular chain. The coupling element uses spring arms to mount to the ossicular chain through the attenuator. The coupling element is not coupled to the attenuator. It does not bias the attenuator toward one another to provide clamping pressure to anchor the attenuator to the ossicular chain. The attenuator retains itself on the ossicular chain, as does the coupling element. These elements function together differently from those claimed herein. Particularly, the spring arms are themselves used for engaging with the coupling site, with the attenuator providing an attenuated connection. The spring arms do not bias jaws or any similar element towards the ossicular chain to anchor such elements to the ossicular chain.

An anticipation can be established only by a single prior art reference disclosing each element of the claim, arranged as in the claim. Muller et al. does not anticipate claim 30, for the reasons discussed above. Therefore, the rejection is improper. Moreover, Muller et al. does not

suggest the claimed invention. Therefore, any obviousness rejection would also be improper.

Claims 31-35 and 37-39 depend from claim 30 and are likewise not anticipated.

Additionally, claim 34 specifies the spring element has opposite ends each received in an opening in one of the jaws to provide swivel joints. There is no such structure disclosed or suggested in Muller et al. Claim 34 is believed allowable for this reason as well.

Claim 35 depends from claim 34 and specifies that the swivel joint is surrounded by an elastomer. While Muller et al. uses an elastic material for an attenuator, it does not use any such material to surround a swivel joint.

The action references Fig. 10 of Muller et al. as a swivel joint. Muller et al. provides no such teaching. The action states that “the spring element 35 has opposite ends each received in an opening (slit) in one of the jaws to provide swivel joints that may further be surrounded by an elastomer (Figs. 26-29)”. Initially, there is no jaw, let alone “one of the jaws”. The slit is in the cylindrical sleeve. The opposite ends of the coupling element are not received in the slit. There is no joint, let alone a swivel joint between the same. Moreover, it is not apparent how this structure would be surrounded by an elastomer or for what purpose. This is an improper hindsight interpretation of the referenced based on applicant’s claim language.

For the above reasons, claims 30-35 and 37-39 are believed allowable and withdrawal of the rejection is requested.

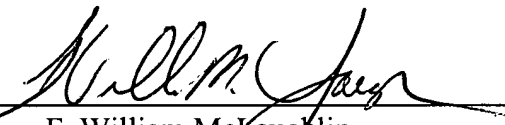
Applicants traverse the rejection of claim 36 as obvious over the Muller et al. '199 patent and further in view of Muller et al. U.S. Patent No. 6,547,715.

Claim 36 depends from claim 30 and further specifies a spacer to temporarily hold the jaws in an open position until implanted in a human ear is completed. The deficiencies with respect to the Muller et al. '199 patent and independent claim 30 are discussed above. The Muller '715 patent does not disclose or suggest these deficiencies. Therefore, no combination of the references results in the claimed invention. Nor does it suggest the claimed invention. Therefore, claim 36 is not obvious over this combination.

Reconsideration of the application and allowance and passage to issue are requested.

Respectfully submitted

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